



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

Ta

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/939,014 | 08/24/2001 | Janet Marie Wasowicz | 2100632-991122 | 3590 |

7590 03/19/2002

Timothy W. Lohse
Gray Cary Ware & Freidenrich
1755 Embarcadero Road
Palo Alto, CA 94303

EXAMINER

HARRIS, CHANDA L

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 03/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Ta

Office Action Summary

| | |
|--------------------------------------|----------------------------------------|
| Application No. 09/939,014 | Applicant(s) WASOWICZ ET AL. |
| Examiner Chanda L. Harris | Art Unit 3713 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 August 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-133 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 78,79 and 93 is/are allowed.
- 6) Claim(s) 1-56,58-73,80,94,96,97,100,104,106,107,110,114,116,117,120,124,126,127 and 130 is/are rejected.
- 7) Claim(s) See Continuation Sheet is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____ . |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

Continuation of Disposition of Claims: Claims objected to are 57,74-77,81-92,95,98,99,101-103,105,108,109,111-113,115,118,119,121-123,125,128,129 and 131-133.

DETAILED ACTION***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

1. Claims 1-56 and 58-73 are rejected under 35 U.S.C. 101 as claiming the same invention as that of Claims 1-68 of prior U.S. Patent No. 6,299,452 B1. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 80, 94, 96-97, 100, 104, 106-107, 110, 114, 116-117, 120, 124, 126-127, and 130 are rejected under the judicially created doctrine of double patenting

over Claims 1-3, and 52 of U. S. Patent No. 6,299,452 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

- [Claim 80]: means for presenting one or more tests to a user, each test determining if the individual has a deficiency in one or more of a reading, a pre-reading and spelling skill --vs-- [patented Claim 52]: means for downloading one or more tests from a server, each test determining if the individual has a deficiency in a reading or pre-reading skill.
- [Claims 94, 100, 104, 110, 114, 120, 124, 130]: providing computer assisted instruction, wherein the computer assisted instruction further comprises providing one or more computer implemented tests to the user to test and diagnose one or more skills of the user using the computer system; providing computer managed instruction wherein the computer managed instruction further comprises recommending a training module in response to computer implemented tests -- vs -- [patented Claim 1]: a server computer comprising one or more tests for determining deficiencies in one or more reading and pre-reading skills; wherein the server computer comprises a recommender for recommending, based on the scores of the one or more tests, one or more training modules for

improving a reading or pre-reading skill of the individual as indicated by the score of the tests.

- [Claims 96, 106, 116, 126]: questioning the individual to elicit information about risk factors associated with language-based learning disabilities -- vs – [patented Claim 2]: a questionnaire having one or more questions for eliciting information about risk factors associated with language-based learning disabilities.
- [Claims 97, 107, 117, 127 -- vs -- patented Claim 3]: These claims are identical.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Allowable Subject Matter

1. Claims 78-79 and 93 are allowed.
2. Claims 57, 74-77, 81-92, 95, 98-99, 101-103, 105, 108-109, 111-113, 115, 118-119, 121-123, 125, 128-129, and 131-133 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Jenkins et al. (US 6,328,569)
-auditory/visual discrimination
- Block et a. (US 6,305,942)
-increased language fluency
- Siefert (US 6,336,813)
-computer-assisted education
- Siefert (US 6,334,779)
-computer-assisted curriculum
- Jenkins et al. (US 6,331,115)
-auditory/visual discrimination
- Everding (US 6,336,089)
-interactive digital phonetic captioning program

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanda L. Harris whose telephone number is 703-308-8358. The examiner can normally be reached on M-F 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone

Art Unit: 3713

numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Chanda L. Harris
Examiner
Art Unit 3713

Ch.

ch.

March 13, 2002

JH-C
Joe H. Cheng
Primary Examiner